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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,125	03/01/2002	Dan Vogel		6507

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02/06/2004

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EXAMINER

MANAHAN, TODD E

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/090,125

Applicant(s)

VOGEL ET AL.

Examiner

Todd E. Manahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 10-12, 18-22, 25-27, 32, 34, 35, 38, 39, 42-58 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9, 13-17, 23, 24, 28-31, 33, 36, 37, 40, 41, 59 and 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

The abstract of the disclosure is objected to because it is not a single paragraph and is too long. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “at least one securing tongue”, as per claim 36, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

Claims 4-8, 10, 11, 12, 18-22, 25-27, 32, 34, 35, 38, 39, 42-58, and 60 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to other claims in the alternative only and a multiple dependent claim can not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1-3, 9, and 11 are rejected under 35 U.S.C. § 101 because they appear to embrace more than one statutory class of invention. Claims which are intended to embrace both product or machine and process is precluded by language of 35 USC 101, which sets forth statutory classes of the invention in the alternative only. These claims recite “A method and delivery system” and thus appear to claim both a method and an apparatus and embrace multiple statutory classes of invention which is prohibited (See Ex parte Lyell, 17 USPQ2d 1548 (1990)).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23, 24 and 28-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the cartridge being made of rigid synthetic resin or plastic, does not reasonably provide enablement for the cartridge being made of “any material”, e.g. wood, paper, cloth, metal, nor enabling for a material that is “doped” (claim 23); while enabling for dispensing light curable dental products, does not reasonable provide enablement for dispensing spray, ink, or decal (claim 24); while enabling for the cartridge being made of synthetic resin or plastic, does not reasonable provide enablement for “any material with a high specific heat”, e.g. Aluminum (claim 30). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Also, the specific polymers recited in claim 31, should be added to the specification.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 9, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 9, and 11 are invalid under 35 USC 112, second paragraph, since a claim which purports to be both machine and process is ambiguous and therefore does not particularly point out and distinctly claim the subject matter of the invention. Ex parte Lyell, 17 USPQ2d 1548 (1990). As such, these claims will not be further treated on the merits thereof.

Claims 13-17, 23, 24, 28-31, 36, 37, 40, 41, and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-17, 23, 24, 28-31, 37, 40, 41, and 59 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. Furthermore, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable and

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the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).. See MPEP § 2173.05(d). In claim 16, lines 1 and 2, "said wall formed by the differing diameters of the inner surface and the outer surface" lacks a prior antecedent. Likewise, claim 17, line 1, "the inner wall" and "the outer wall" lack prior antecedents.

In claim 24, the functional recitation that "application of any spray, ink, decal and the like (sic) that when current is applied heat...." is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-15, 30, 31, 33, 36, 37, 40, and 41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dougherty (United States Patent No. 4,391,590).

Dougherty discloses a cartridge comprising a hollow elongated uniformly cylindrical body 34 molded from a rigid plastic material. One end 56 of the body is open and formed with a recess at the distal extremity thereof. A discharge nipple 64 is integrally molded with the body and includes a passage therethrough extending from the closed end of the body. A piston 68 is

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inserted into the open end of the body and sealing means in the form of a cup-shaped cap 70 is removably attached to the nipple. The body and piston are formed of colored plastic to render them opaque (col. 4, lines 56-61). The cap may also be color-coded to indicate properties of the contents of the cartridge (col. 4, lines 52-55). Dougherty also discloses a delivery device for the cartridge comprising a housing 10 which accommodates the cartridge, a slideable plunger 18 arranged in the rearward end of the housing, a pivot handle 24 for actuating the plunger.

Claims 13, 16, 17, 23, 24, and 28-30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fiveash (United States Patent No. 3,858,985).

Fiveash discloses a cartridge comprising a hollow elongated uniformly cylindrical body 11. One end of the body is open and formed with a recess at the distal extremity thereof. A discharge nipple 16 is integrally molded with the body and includes a passage therethrough extending from the closed end of the body. A piston 54 is inserted into the open end of the body and a cup-shaped cap 68 is removably attached to the nipple. Electrical wires are disposed within the wall of the cylindrical body to provide heat to the contents of the cartridge and appropriate connectors are also provided.

Claims 33 and 59 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Martin et al. (United States Patent No. 5,100,320).

Martin et al. disclose a cartridge combined with a delivery device in which the piston is moved by a motor to dispense the material (see col. 5, lines 22-31).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



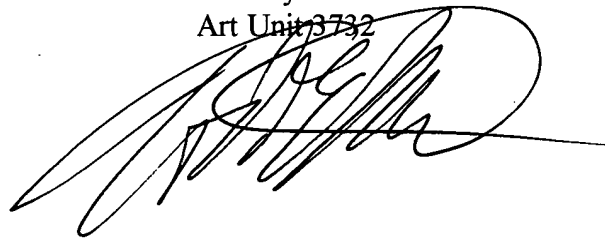
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 703 308-2695. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan  
Primary Examiner  
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A handwritten signature in black ink, appearing to read 'T. E. Manahan', is written over the printed name and title.

T. E. Manahan  
4 February 2004